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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/319,108 05/27/99 BERGHOFER J 99.186

IM62/0601
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EXAMINER

HARDEE, J

ART UNIT	PAPER NUMBER
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1751

DATE MAILED:

06/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/319,108

Applicant(s)
Berghofer et al.

Examiner
John R. Hardee

Group Art Unit
1751



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-25 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, 8, 10-12, 15-18 and 23-25, drawn to compounds, compositions and methods in which R1 is OH and R3 is COOM or COOR4.

Group II, claim(s) 1-6, 8, 11, 12 and 23-25, drawn to compounds, compositions and methods in which R1 is NR4R5 and R3 is COOM or COOR4.

Group III, claim(s) 1-4, 11, 12 and 23-25, drawn to compounds, compositions and methods in which R1 is OH and R3 is SO3M

Group IV, claim(s) 1-4, 11, 12 and 23-25, drawn to compounds, compositions and methods in which R1 is NR4R5 and R3 is SO3M

Group V, claim(s) 1-4, 11, 12 and 23-25, drawn to compounds, compositions and methods in which R1 is OH and R3 is COR4

Group VI, claim(s) 1-4, 11, 12 and 23-25, drawn to compounds, compositions and methods in which R1 is NR4R5 and R3 is COR4.

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 7:30 until 4:00. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'J. R. Hardee', with a stylized, cursive script.

John R. Hardee
Patent Examiner
May 31, 2000

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Group VII, claim(s)1-4, 11, 12 and 23-25, drawn to compounds, compositions and methods in which R1 is NR4R5 and R3 is CONR4R5

Group VIII, claim(s)1-4, 11, 12 and 23-25, drawn to compounds, compositions and methods in which R1 is NR4R5 and R3 is CONR4R5

Group IX, claim(s)1-4, 7-14 and 23-25, drawn to compounds, compositions and methods in which R1 is OH and R3 is H

Group X, claim(s)1-4, 7-9, 11, 12 and 23-25, drawn to compounds, compositions and methods in which R1 is NR4R5 and R3 is H.

Claim 19 is an omnibus claim. While it arguably falls into all ten of the groups, it is indefinite, and the examiner recommends that it be cancelled.

2. The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1, at least, is anticipated by DE 1,240,035, which discloses phenyl hydroxymethyl sulfinic acid. Therefore, any special technical feature which unites the claims does not make a contribution over the prior art, and restriction is appropriate.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. A telephone call was made to Mr. Michael Greenfield on May 30, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made.